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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,438	05/24/2001	Sam Alexander	DN 1431	2656
26483	7590	05/12/2005	EXAMINER	
ANCEL W. LEWIS, JR. 425 WEST MULBERRY SUITE 101 FORT COLLINS, CO 80521			VIG, NARESH	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/864,438	ALEXANDER ET AL.	
	Examiner	Art Unit	
	Naresh Vig	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20010524</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1 – 8 only recites an abstract idea. The recited steps of merely providing a database, receiving user data including selected service, recommending service provider, getting performance data from user and refining

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performance data of service provider does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to select an insurance policy over another.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention gathers performance data from users and refines performance data of service providers (i.e., repeatable) used in recommending service providers to users (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al. US Patent 4799156 hereinafter known as Shavit in view of Raveis US Patent 6321202 and eBay, Inc. hereinafter known as EBay.

Regarding claims 1 and 10, Shavit teaches system and method for facilitating a relocation (field of use, an interactive on-line electronic communications and processing of business transactions between a plurality of different types of independent users including at least a plurality of sellers, and a plurality of buyers, as well as financial institutions, and freight service providers) [abstract]. Shavit teaches providing a database having stored data for plurality of service providers [col.6, lines 4 – 18]. Shavit does not teach providing a relocation database (database configured to be used for storing information related to relocation) having stored performance data for a plurality of relocation service providers, said stored performance data including cost and quality. Raveis teaches system and method for managing transactions. Raveis teaches vendor databases preferably relate to relocation companies, relocation fee percentages, relocation company phone numbers, signs, sign vendors, mailings to vendors and the like [col. 7, lines 8 – 10]. Official notice is taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a design choice to decide what information is stored in a database. A business can design table(s) in a database to meet their business requirements.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shavit as taught by Raveis to use Shavit to manage information by automating relocation related service business (field of use).

Shavit in view of Raveis teaches:

receiving user data from a user including at least one selected service and user preferences for each said selected service (interactive session, customer inquiry, sales order entry) [Shavit, Fig 26 and disclosure associates with Fig. 26].

providing at least one service provider initial recommendation to said user for each said selected service, each said initial recommendation designating a service provider (Shavit teaches that its system and method can suggest). Shavit does not teach suggestion to include an estimated cost for said service provider and an estimated probability of said service provider successfully fulfilling said user preferences. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a design choice to decide what information should be displayed to the consumer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shavit in view of Raveis and display suggestion which includes an estimated cost for said service provider and an estimated probability of said service provider successfully fulfilling said user preferences to help consumer make an educated decision.

Shavit in view of Raveis does not teach performance data for a plurality of relocation service providers (sellers). However, EBay teaches performance data for a plurality of sellers [Page 2].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shavit in view of EBay and give incentives to users for providing feedback to minimize the skew of data in one direction.

Regarding claim 2, Shavit in view of Raveis and EBay teaches:

receiving modified user preferences in response to said initial recommendation from said user (order amendment) [Shavit, Fig 26 and disclosure associates with Fig. 26], and

providing at least one service provider final recommendation to said user for each said selected service, each said final recommendation designating a service provider and including an estimated cost for said service provider and an estimated probability of said service provider successfully fulfilling said user preferences [Shavit, Fig 26 and disclosure associates with Fig. 26].

Regarding claims 3 and 14 – 15, Shavit in view of Raveis and EBay does not teach receiving service provider new performance data from said user after completion of each said selected service, combining said new performance data with said stored performance data to refine said stored performance data and to reduce dispersion (degree of scatter of data) of said stored performance data. However, EBay teaches

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system and method of receiving service provider new performance data from said user after completion of each said selected service, combining said new performance data with said stored performance data to refine said stored performance data and to reduce dispersion (degree of scatter of data) of said stored performance data [page 2].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shavit in view of Raveis as taught by EBay to empower a user to make an informed choice about someone they plan to do business with.

Regarding claim 4, Shavit in view of Raveis and EBay does not teach providing rewards to said user in response to receiving said new performance data. However, Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a business choice to decide whether they want to provide incentives to user for providing feedback.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shavit in view of EBay and give incentives to users for providing feedback to minimize the skew of data in one direction.

Regarding claim 5, as responded to earlier in response to claim 1, it would have been obvious to one or ordinary skill in the art that Shavit in view of Raveis and EBay teaches said estimated probability is the product of a probability of writing a contract with one said service provider and a probability of executing said contract (field of use).

Regarding claims 6 and 11 – 13, as responded to earlier in response to claims 1 – 5, it would have been obvious to one of ordinary skill in the art that Shavit in view of Raveis and EBay teaches:

said stored performance data includes quoted performance data and actual performance data for each said service provider (design choice to elect what data is collected and stored to meet business requirements),

said probability of writing a contract for a selected service is the probability that said quoted performance data for at least one said service provider fulfills each of said user preferences for said selected service (design choice to elect what data is collected and stored and utilized to meet business requirements), and

said probability of executing said contract is the probability that a said service provider having quoted performance data that fulfills each of said user preferences for said selected service will fulfill each of said user preferences for said selected service (design choice to elect what data is collected and stored and utilized to meet business requirements).

With respect to the recitation defining what kind of data is being stored on the database, this is considered to be non-functional descriptive material that does not distinguish (define) over the applied prior art. In article claims and the type of data claimed is considered to be non-functional descriptive material, the applied prior art satisfies the claim. The prior art stores data and is fully capable of storing the claimed type of data, this is the extend to which weight will be given to the claimed data. When

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descriptive material is not functionally related to the article, the descriptive material will not distinguish the invention from the prior art in terms of patentability, *In re Gulack*, 217 USPQ 401 (CAFC 1983).

Regarding claim 7, as responded to earlier in response to claims 1 – 6, it would have been obvious to one of ordinary skill in the art that Shavit in view of Raveis and EBay teaches said selected service is selected from a group of services including home selling assistance, home buying assistance, home mortgage assistance, personal property shipping assistance, temporary living assistance, and hookup and disconnect services (business choice to elect type of users for the system and method).

Regarding claim 8, as responded to earlier in response to claims 1 – 7, it would have been obvious to one of ordinary skill in the art that Shavit in view of Raveis teaches:

comparing said user preferences to said stored performance data for each service provider for each said selected service [Ebay, sellers are given stars based upon the feedback from the users], and

selecting at least one said service provider with stored performance data that most closely fulfills said user preferences at the lowest said cost and highest said quality for each said selected service (design choice to elect how the query the database to select the vendor from the database).

Regarding claims 9 and 16, Shavit teaches system and method for facilitating a relocation (field of use, an interactive on-line electronic communications and processing of business transactions between a plurality of different types of independent users including at least a plurality of sellers, and a plurality of buyers, as well as financial institutions, and freight service providers) [abstract].

Shavit teaches providing a database having stored data for plurality of service providers [col.6, lines 4 – 18]. Shavit does not teach providing a relocation database (database configured to be used for storing information related to relocation) having stored performance data for a plurality of relocation service providers, said stored performance data including cost and quality. Raveis teaches system and method for managing transactions. Raveis teaches vendor databases preferably relate to relocation companies, relocation fee percentages, relocation company phone numbers, signs, sign vendors, mailings to vendors and the like [col. 7, lines 8 – 10]. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a design choice to decide what information is stored in a database. A business can design table(s) in a database to meet their business requirements.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shavit as taught by Raveis to use Shavit to manage information by automating relocation related service business (field of use).

Shavit in view of Raveis teaches:

receiving user data from a user including at least one selected service and user preferences for each said selected service (interactive session, customer inquiry, sales order entry) [Shavit, Fig 26 and disclosure associates with Fig. 26].

providing at least one service provider initial recommendation to said user for each said selected service, each said initial recommendation designating a service provider (Shavit teaches that its system and method can suggest). Shavit does not teach suggestion to include an estimated cost for said service provider and an estimated probability of said service provider successfully fulfilling said user preferences. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a design choice to decide what information should be displayed to the consumer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shavit in view of Raveis and display suggestion which includes an estimated cost for said service provider and an estimated probability of said service provider successfully fulfilling said user preferences to help consumer make an educated decision.

Shavit in view of Raveis does not teach performance data for a plurality of relocation service providers (sellers). However, EBay teaches performance data for a plurality of sellers [Page 2].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shavit in view of EBay and give incentives to users for providing feedback to minimize the skew of data in one direction.

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As responded to earlier in response to claims 1 – 8, Shavit in view of Ravies and EBay teaches:

receiving user data from a user including at least one selected service and user preferences for each said selected service, said selected service being selected from a group of services including home selling assistance, home buying assistance, home mortgage assistance, personal property shipping assistance, temporary living assistance, and hookup and disconnect services,

providing at least one service provider initial recommendation to said user for each said selected service including comparing said user preferences to said stored performance data for each service provider for each said selected service and selecting as a selected service provider at least one said service provider with stored performance data that most closely fulfills said user preferences at the lowest said cost and highest said quality for each said selected service, each said initial recommendation designating said selected service provider and including an estimated cost for said selected service provider and an estimated probability of said selected service provider successfully fulfilling said user preferences, said estimated probability being the product of a probability of writing a contract with one said service provider and a probability of executing said contract, said probability of writing a contract for a selected service being the probability that said quoted performance data for at least one said service provider fulfills each of said user preferences for said selected service, said probability of executing said contract being the probability that a said service provider

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having quoted performance data that fulfills each of said user preferences for said selected service will fulfill each of said user preferences for said selected service.

Shavit in view of Raveis and EBay teaches:

receiving modified user preferences in response to said initial recommendation from said user (capability of user modifying a search query, design choice to decide whether to create new search criteria e.g. search on www.google.com, or, allowing user to modify search, e.g. search within a search e.g. www.excite.com, advanced search e.g. advanced search on www.google.com), and

providing at least one service provider final recommendation to said user for each said selected service, each said final recommendation designating a service provider and including an estimated cost for said service provider and an estimated probability of said service provider successfully fulfilling said user preferences (responded to earlier in response to claims 1 – 8),

receiving service provider new performance data from said user after completion of each said selected service (EBay teaches this limitation),

combining said new performance data with said stored performance data to refine said stored performance data and to reduce dispersion of said stored performance data (Ebay teaches this limitation), and

providing rewards to said user in response to receiving said new performance data (responded to earlier in response to claims 1 – 8).

Conclusion

Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naresh Vig
Examiner
Art Unit 3629

May 10, 2005